

REMARKS

Claims 1-23 are all the claims pending in the application. Claim 22 has been amended to recite a step of ejecting or discharging an ink-jet recording composition.

Entry of the above amendment is respectfully requested.

Initially, the Examiner is respectfully requested to return a signed and initialed Form PTO/SB/08 A & B (modified) filed with Applicants' IDS on February 21, 2007, indicating that the listed documents have been considered and made of record.

I. Response to Rejection of claims 1 and 22 under 35 U.S.C. § 102(b)

Claims 1 and 22 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Shibahara (US 5,753,422).

The rejection is respectfully traversed.

Claim 1 is directed to an ink composition comprising a pigment and a compound represented by General formula (I). In addition, claim 22 is directed to an image forming method using an ink-jet recording ink comprising a pigment and a compound represented by General formula (I).

The Examiner asserts Shibahara teaches a pigment and a compound represented by the following General formula (I), however, the Examiner states the Shibahara discloses a silver halide. *See* col. 12, lines 10-68, col. 4, lines 1-10 and col. 19, lines 30-38.

It is respectfully submitted that Shibahara does not disclose the composition of claim 1 or the method of claim 22.

First, Shibahara relates to a silver halide color photographic material and has nothing to do with an ink-jet recording ink. Second, Shibahara does not disclose the use of a pigment.

Third, the Examiner appears to consider the repeating unit $-\text{CH}_2-\text{C}(\text{COOM})\text{H}-$ where M is a cation as corresponding to repeating unit C where R^3 , R^4 and Z^1 are H and Z^2 is COOH. However, Shibahara does not disclose a compound represented by General formula (I). Specifically, Shibahara does not disclose a compound where X is a bivalent linking group having a hetero bond (such as an ether bond, an ester bond, a thioether bond, a thioester bond, a sulfonyl group, an amide bond, an imide bond, a sulfonamide bond, a urethane bond, a urea bond, or a thiourea bond).

Thus, for at least the above distinctions, Shibahara does not anticipate claim 1 or 22.

In addition, the polymer in the silver halide color photosensitive material of Shibahara is present in a film of a photosensitive material. The purpose of using the polymer is to promote the penetration of a developer into the film of the photosensitive material when the photosensitive material is developed. This penetration of a developer into the film promotes an elution of the silver halide from the film and a sensitizing development of the photosensitive material.

In contrast, the polymer of the present invention is contained in an ink-jet recording ink, which allows excellent dispersion stability of dispersed particles and storage stability of the ink, thereby suppressing ink-clogging in nozzles when the ink is used as an ink-jet recording ink. These superior effects of an ink-jet recording ink are made possible in the present invention by having the polymer contained in the ink.

Accordingly, the ink-jet recording ink of the present invention is completely different from the silver halide color photosensitive material of Shibahara in terms of composition, technical field, problem to be solved, and effect.

In view of the above, withdrawal of the rejection is respectfully requested.

II. Response to Rejection of Claims 2-7, 9-11, 13-15, 17, 18 and 23 under 35 U.S.C. §103(a)

Claims 2-7, 9-11, 13-15, 17, 18 and 23 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Shibahara in view of Kubodera (JP 10-095942).

The rejection is respectfully traversed.

It is respectfully submitted that each of claims 2-7, 9-11, 13-15, 17, 18 and 23 depend, directly or indirectly, from claim 1 or 22, and thus, it is respectfully submitted that these claims are patentable for at least the same reasons as claim 1 or 22.

In addition, it is respectfully submitted that there is no motivation to combine Shibahara and Kubodera.

As discussed above, Shibahara is not directed to an ink, but is directed to a silver halide color photographic material. In contrast, Kubodera is directed to a recording liquid containing a water-soluble dye. Thus, Shibahara and Kubodera are directed to different technical fields, and one of ordinary skill in the art would not look to Kubodera to modify the photographic material of Shibahara to arrive at the present invention. Accordingly, there is teaching or suggestion in the references lead one of ordinary skill in the art to combine the references, and a *prima facie* case of obviousness has not been established.

In view of the above, withdrawal of the rejection is respectfully requested.

III. Response to Rejection of Claim 8 under 35 U.S.C. §103(a)

Claim 8 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Shibahara in view of Aoshima (US 6,068,963).

The rejection is respectfully traversed.

It is respectfully submitted that claim 8 depends from claim 1, and thus, it is respectfully submitted that claim 8 is patentable for at least the same reasons as claim 1.

In addition, it is respectfully submitted that there is no motivation to combine Shibahara and Aoshima.

As discussed above, Shibahara is not directed to an ink, but is directed to a silver halide color photographic material comprising a support having thereon a red-sensitive silver halide emulsion layer, a green-sensitive silver halide emulsion layer, and a blue-sensitive silver halide emulsion layer. In contrast, Aoshima relates to a negative-type image recording material. Specifically, Aoshima discloses that the invention relates to image recording materials which may be used as planographic printing plate materials, color proofs, dry lith type film, photo resists, or color filters. Thus, Aoshima does not relate to silver halide color photographic materials. Since Shibahara and Aoshima are directed to different technical fields, one of ordinary skill in the art would not look to Aoshima to modify the silver halide photographic material of Shibahara to arrive at the present invention. Accordingly, there is teaching or suggestion in the references that would motivate one of ordinary skill in the art to combine the references, and a *prima facie* case of obviousness has not been established.

In view of the above, withdrawal of the rejection is respectfully requested.

IV. Response to Rejection of Claim 12 under 35 U.S.C. §103(a)

Claim 12 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Shibahara in further view of Leppard et al. (US 6,048,660).

The rejection is respectfully traversed.

It is respectfully submitted that claim 12 depends from claim 1, and thus, it is

respectfully submitted that claim 12 is patentable for at least the same reasons as claim 1.

In addition, it is respectfully submitted that a *prima facie* case of obviousness has not been established. To establish a *prima facie* case of obviousness, the Examiner must present a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. The Examiner has not done so in this case, and has simply made a statement that it would have been obvious to modify the "ink" of Shibahara to provide for a stable ink composition, particularly when neither reference relates to an ink composition without providing any reasoning or basis for his position.

In view of the above, withdrawal of the rejection is respectfully requested.

V. Response to Rejection of Claims 16 and 20 under 35 U.S.C. §103(a)

Claims 16 and 20 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Shibahara, Kubodera, further in view of Aono et al. (JP 07-219113).

The rejection is respectfully traversed.

It is respectfully submitted that claims 16 and 20 depend from claim 1, and thus, it is respectfully submitted that claims 16 and 20 are patentable for at least the same reasons as claim 1.

It is respectfully submitted that a *prima facie* case of obviousness has not been established because there is no motivation to combine Shibahara and Kubodera and because the Examiner must present a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. As discussed above, Shibahara is not directed to an ink, but is directed to a

silver halide color photographic material, and Kubodera is directed to a recording liquid containing a water-soluble dye. Thus, Shibahara and Kubodera are directed to different technical fields, and one of ordinary skill in the art would not look to Kubodera to modify the photographic material of Shibahara to arrive at the present invention.

In view of the above, withdrawal of the rejection is respectfully requested.

VI. Response to Rejection of claim 19 under 35 U.S.C. §103(a)

Claim 19 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Shibahara in view of Yamanouchi et al. (US 2002/0143079).

The rejection is respectfully traversed.

It is respectfully submitted that claim 19 depends from claim 1, and thus, it is respectfully submitted that claim 19 is patentable for at least the same reasons as claim 1.

In addition, it is respectfully submitted that a *prima facie* case of obviousness has not been established because there is no motivation to combine Shibahara and Yamanouchi since the references are directed to different technical skills. That is, Shibahara relates to a silver halide color photographic material, whereas Yamanouchi relates to ink jet composition. Thus, one of ordinary skill in the art would not look to Yamauchi to modify the photographic material of Shibahara to arrive at the present invention.

In view of the above, withdrawal of the rejection is respectfully requested.

VII. Response to Rejection of Claim 21 under 35 U.S.C. §103(a)

Claim 21 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Shibahara in view of Nishita (US 2002/0060727).

The rejection is respectfully traversed.

It is respectfully submitted that claim 21 depends from claim 1, and thus, it is respectfully submitted that claim 21 is patentable for at least the same reasons as claim 1.

In addition, it is respectfully submitted that a *prima facie* case of obviousness has not been established because there is no motivation to combine Shibahara and Nishita since the references are directed to different technical skills. Specifically, Shibahara relates to a silver halide color photographic material, whereas Nishita relates to ink jet recording method. Thus, one of ordinary skill in the art would not look to Nishita to modify the photographic material of Shibahara to arrive at the present invention.

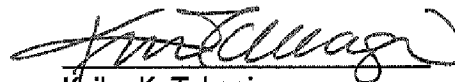
In view of the above, withdrawal of the rejection is respectfully requested.

VIII. Conclusion

For the foregoing reasons, reconsideration and allowance of claims 1-23 is respectfully requested.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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